

REMARKS

Claims 1 through 3 and 5 are pending in this Application. Claims 1 and 5 have been amended and claim 4 cancelled. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, page 5 of the written description, lines 15 and 16, noting that the limitations of claim 4 have been incorporated into claims 1 and 5. Applicants submit that the present Amendment does not generate any new matter issue.

In the June 11, 2004 Office Action, the Examiner imposed the following rejections:

1. **Claims 1 through 5 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Tsuchiya et al.;**
2. **Claims 1 through 5 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Ohga et al.; and**
3. **Claims 1 and 4 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Suzuki et al.**

Each of the above rejections under 35 U.S.C. § 102 is traversed. Specifically, the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed inventions and

the apparatus and method disclosed in each of Tsuchiya et al., Ohga et al. and Suzuki et al. that scotch the factual determination that any of Tsuchiya et al., Ohga et al. and Suzuki et al. disclose an apparatus and method identically corresponding to those claimed.

In accordance with the present invention, the first muffler tube not only has a hollow cylinder but also a cover member and a bottom member. The second muffler tube has not only a hollow cylinder but also a cover member and a bottom member. Moreover, the entire circumference of the first muffler tube is surrounded by the second muffler tube. No such apparatus or method employing such an apparatus is disclosed or suggested by any of the applied references. Indeed, in each of Tsuchiya et al., Ohga et al. and Suzuki et al., at least a part of the muffler tube is a double layered structure. However, the muffler tube is not constructed of a first muffler tube and a second muffler tube such that the entire circumference of the first muffler tube is surrounded by the second muffler tube.

The above argue differences between the claimed apparatus and method and those disclosed by each of the applied references undermine the factual determination that any of Tsuchiya et al., Ohga et al. and Suzuki et al. disclose a method and apparatus identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 5 under 35 U.S.C. § 102 for lack of novelty as evidenced by Tsuchiya et al., the imposed rejection of claims 1 through 5 under 35 U.S.C. § 102 for lack of novelty as evidenced by Ohga et al. and the imposed rejections of claims 1 and 4 under 35 U.S.C. § 102 for lack of novelty as evidenced by Suzuki et al. are not factually viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that each of the imposed rejections has been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'A. J. Steiner', is written over the printed name.

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